

REMARKS

Favorable reconsideration and allowance of this application are requested.

1. Discussion of Claim Amendments

By way of the amendment instructions above, claim 1 has been amended so as to include the substance of prior claim 3. As such, claim 3 has been canceled as redundant. Claim 1 has also been revised so as to recite that Components (A), (B) and (C) are present in amounts of 20-70 wt.%, 10-60 wt.% and 10-25 wt.% respectively. Support for such amended ranges may be found in the originally filed specification at page 6, lines 25-26, page 8, lines 33-34 and page 9, lines 19-20, respectively.

Claims 10 -13 are new and dependent from the amended version of claim 1. Support for new claim 10 can be found in the specification at page 7, line 25 and Page 17, Table 1, Examples 3 and 4 (i.e., the amounts of Component B-1). Support for claim 11 can be found on Page 17, Table 1, (i.e., the sum of all Components B-1 through B-4, if present, in Examples 1 through 6). Support for new claim 12 is based on the sum of components B-1 to B-3 in Examples 1-6 which are the monofunctional (meth)acrylates represented by formula (1). Support for new claim 13 can be found in the specification at page 8, lines 1-6.

Therefore, following entry of this amendment, claims 1-2 and 4-13 will remain pending herein for consideration.

2. Response to Substantive Rejections

A. Response to Rejection under 35 USC §§102(e)/103(a) based on Takase et al

Claims 1-3 and 5-9 attracted a rejection under 35 USC §102(e) as anticipated by or alternatively under 35 USC §103(a) as obvious over Takase et al (US Publication 2003/0021943 and USP 6,710,097). Applicants respectfully suggest that the presently pending claims are patentably distinguishable over Takase et al.

In this regard, applicants note that the weight ratio of the component (C) is recited in pending claim 1 as being present in an amount of 10—25 wt%. By providing component (C) at the weight ratio of 10-25 wt%, high restorability can be obtained as shown in [0043], [0077] and [0078] in the specification.¹

Takase et al does not however disclose compositions containing a (meth)acrylate monomer having four or more functional groups at a weight ratio of 10 wt% or more. The compositions of Example 4 in Table 1 on page 7 of Takase et al contains component (E-5), which can be considered as correspondent with the component (C) of pending claim 1, at the weight ratio of 1.9 wt%. However, the high restorability which is achieved by the compositions of the present invention cannot be obtained by at such a low weight ratio of component (C).

The examiner asserts on page 3, last five lines from page bottom in the Office Action that "...because the polyfunctional compounds are disclosed as useable in the composition it is deemed that these are equivalents and thus the combination of polyfunctional materials anticipates the 5-25 wt% limitation. In addition, because they are disclose as equivalents it would have been within the skilled artisans level to use up to 22-wt% of the disclosed hexafunctional (meth)acrylate compound". (emphasis added)

In fact, the weight ratio of the **total amount** of components (E-3), (E-4) and (E-5) in the composition of Example 4 in Table 1 on page 7 of Takase is 22.2 wt% (i.e. $10.64 + 9.7 + 1.9 = 22.2$ wt%).

However, polyfunctional compounds are not equivalents. In this regard, Components (E-3) and (E-4) of Example 4 of Takase et al are compounds having two or less functional groups, and are equivalent to "4EGA (tetraethylene glycol diacrylate);, which is a compound having two functional groups, of Comparative Example 1 in Table 1, paragraph [0078] in the specification. Significantly, the composition of Comparative

¹ Citations are to paragraphs in the published patent application US 2005/0261392 A1.

Example 1 has poor restorability as shown by the data therein. Thus, this data unequivocally shows the non-equivalency between polyfunctional compounds.

Accordingly, the present invention cannot be anticipated by or rendered obvious from Takase et al. Withdrawal of the rejection advanced alternatively under 35 USC §102(e)/103(a) is therefore in order.

B. Response to Rejection under 35 USC §102(b) based on Duecker et al

Duecker et al (USP 5,881,194, 6,122,428 and 6,449,413) have been applied to reject prior claims 1, 5-6 and 8-9 under 35 USC §102(b). In this regard, applicants note that amendment to claim 1 so as to include therein the substance of prior claim 3 renders moot this rejection. Withdrawal of the same is in order.

C. Response to Rejection under 35 USC §§103(a) based on Takase et al in view of Yamashita et al

Yamashita et al (2003/0021943 and 6,710,097) have been combined with Takase et al to reject claim 4 under 35 USC §103(a). The comments above are equally germane to the non-obviousness of the present invention as defined by pending claim 4, particularly in view of the amended version of claim 1 presented above.

As explained previously, the composition of Example 4 of Takase et al contains component (E-5), which coincides with the component (C) of the present invention, at the weight ratio of 1.9 wt%. This value (1.9 wt%) is not within the range of "10-25 wt%" of the amended version of claim 1. Moreover, the high restorability achieved by the compositions of the present invention cannot be obtained by such a low weight ratio (1.9 wt%) of component (C).

Yamashita likewise does not describe compositions containing a compound which coincides with the component (C) of the present invention at the weight ratio of 10 wt% or more.

Accordingly, the present invention is patentably *non*-obvious over Takase et al and Yamashita.

Moreover, applicants note that this application and Takase et al were owned by the same corporate entities as of the dates of the respective inventions. Thus, since Takase et al rises to "prior art" status only under 35 USC §102(e), it is precluded from being employed as a reference under 35 USC §103(c). To be sure, the applicants make the following representation:

Statement of Common Ownership: The above-identified application and Takase et al (2003/0021943 and USP 6,710,097) were, at the time the invention of the above-identified application was made, owned by the same companies, namely DSM IP Assets BV (formerly DSM NV), JSR Corporation and Japan Fine coatings Co., Ltd.

3. Fee Authorization

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

Respectfully submitted,

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